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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,664	09/30/2004	Li-Hsien Yen	10026-US-PA-0C	5663

31561 7590 12/09/2004

JIANQ CHYUN INTELLECTUAL PROPERTY OFFICE
7 FLOOR-1, NO. 100
ROOSEVELT ROAD, SECTION 2
TAIPEI, 100
TAIWAN

EXAMINER

LAM, CATHY FONG FONG

ART UNIT PAPER NUMBER

1775

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,664

Applicant(s)

YEN ET AL.

Examiner

Cathy Lam

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 10/604,393.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

Claim Rejections - 35 USC § 112

1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is vague and indefinite as to what "a far infrared ceramic" is referring to?

Claim Rejections - 35 USC § 102/103

2. Claims 1, 2, 4, 6-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kambe et al (US 5938979).

Kambe discloses an electromagnetic shielding material comprised of a polymer binder (504) and magnetic particles (502) (Fig. 5).

The magnetic particles are nanoscale particles that are imbedded in the polymer binder (col 10 L 51-54 & L 65-66). The magnetic particles including ¹ ferric oxides (ie. Fe₂O₃) and carbon containing compounds (col 10 L 27 & L 29-33). Carbon fibers, carbon black, graphite or metal particles may be imbedded in the polymer binder to form a shielding layer (col 11 L 31-37).

The electromagnetic shielding material is formed into a layer over which a second layer (558) which can be a metal layer is formed (col 11 L 50-52 & Fig. 6).

Kambe teaches the present invention but only in a single layer of EM shielding layer and a single layer of metal layer (Fig. 6). However, making Kambe's invention from a single layer to a multilayer would be an obvious modification.

¹ Kim (US Patent 5,686,781) ferric oxide (i.e. Fe₂O₃) is an example of a far-infrared emitting material: column 3 lines 35 -38.

3. Claims 1, 2, 4-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Allen et al (US 6410847).

Allen discloses an EM wave absorbing material comprised of a molded body (18) and a cover (16). The cover (16) is plated over the entire exterior surface of the molded body (18) (Fig. 2e, col 3 L 32-37).

The molded body is a composite material comprised of a plastic material and an EM wave absorbing material (col 4 L 32-34). The EM wave absorbing material is fillers such as metal coated graphite, carbon fibers, etc. (col 4 L 42-48).

The cover (16) is comprised of a copper layer and a nickel layer (col 5 L 7-12).

The prior art only teaches a single layer of EM wave shielding plastic material. The examiner takes the position that making the structure a multilayer arrangement is an obvious variation.

4. Claims 1-2, 4-6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gabower (US 6570085).

Gabower teaches an EM shielding material comprised of a thermoformable polymeric sheet (25) and thin metal layers (27,29) (Fig. 2).

The thermoformable polymeric sheet (25) is comprised of a polymeric material and fillers. The fillers are carbon black or graphite (col 3 L 40-53). Two thin metal films (27,29) are coated onto the surfaces of the polymeric sheet (col 3 L 40-42). The metal films are aluminum or copper films (col 5 L 11-16).

The prior art only teaches a single layer of EM shielding sheet, however additional layers of such sheet would be an obvious variation.

Claim Rejections - 35 USC § 103

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambe et al (US 5938979) or Allen et al (US 6410847) or Gabower (US 6570085).

All of the prior art teach an EM wave shielding material comprised of a carbon or carbon compound filled polymeric resin material and metallic film(s) formed thereover.

The prior art however does not teach the shielding is in a multilayer structure, nor do they mention the thickness of the metallic film(s).

In view of the prior art teachings, one skill in the art would fabricate a multilayer EM shielding structure because add on layers would increase the EM wave shielding effect.

Furthermore, one skill in the art would choose the appropriate metallic film thickness because it controls the shielding effects.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-8 are provisionally rejected under the judicially created doctrine of

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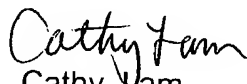
obviousness-type double patenting as being unpatentable over claims 1-7 and 10 of copending Application No. 10/604,393. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are structurally and materially the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (571) 272-1538. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cathy Lam
Primary Examiner
Art Unit 1775

cfl
December 1, 2004